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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,171	06/23/2003	Richard L. Mueller JR.	ACU-126	9435

7590 07/11/2005

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EXAMINER
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SZMAL, BRIAN SCOTT

ART UNIT	PAPER NUMBER
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3736

DATE MAILED: 07/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/602,171

Applicant(s)

MUELLER, RICHARD L.

Examiner

Brian Szmal

Art Unit

3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2,3,8-14 and 25-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2,3,8-14 and 25-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 2, 3 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suci et al (4,227,537).

Suci et al discloses a cytology brush and further disclose a bristle shank; a bristle structure on the shank and having bristles of sufficient stiffness to loosen cytology material without substantial traumatization of tissue; a brush handle; a coupling for releasably attaching the bristle shank to the handle; the bristle shank has an atraumatic tip; and the bristles are nylon bristles. See Figures 1 and 9; Column 4, lines 19-35 and 50-60; and Column 5, lines 30-37.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to utilize a corkscrew as a coupling element in the place of the coupling element of Suci et al because the Applicant has not disclosed that the use of a corkscrew coupling element provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected the coupling element of Suci et al and the Applicant's invention to perform equally well with either the coupling element taught by Suci et al because both coupling elements couple a handle to a cytology brush.

Art Unit: 3736

3. Claims 9 and 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suciu et al (4,227,537) as applied to claim 8 above, and further in view of Vermeulen (5,201,323).

Suciu et al, as discussed above, disclose a cytology brush, but fail to disclose an elongated housing for the brush handle and a biopsy site marker releasably carried by the cytology brush in the elongated housing; a detent for limiting axial travel of the brush handle within the elongated housing; the detent is removably secured to the brush handle; and the brush handle is slidably mounted in the elongated housing and the detent is mounted to the elongated housing.

Vermeulen discloses a wire-guided cytology brush and further disclose an elongated housing for the brush handle and a biopsy site marker releasably carried by the cytology brush in the elongated housing; a detent for limiting axial travel of the brush handle within the elongated housing; the detent is removably secured to the brush handle; and the brush handle is slidably mounted in the elongated housing and the detent is mounted to the elongated housing. See Figures 1 and 3.

Since both Suciu et al and Vermeulen disclose cytology brush systems, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the cytology brush system of Suciu et al to include the use of a detent and a biopsy marker, as per the teachings of Vermeulen, since it would provide a means of preventing the removal of the brush as well as marking the site from which the biopsy was taken.

Art Unit: 3736

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art at the time the invention was made to mount the detent of Vermeulen in a hinged relationship with the housing since the Applicant has not disclosed that the hinged mounting of the detent provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Vermeulen's detent, and the Applicant's invention to perform equally well with either detent taught by Vermeulen or the claimed detent because both detents prevent the removal of the brush from the elongated housing.

4. Claims 25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suci et al (4,227,537) in view of Vermeulen (5,201,323).

Suci et al, as discussed above, disclose a cytology brush and further disclose a bristle shank; a bristle structure on the shank and having bristles of sufficient stiffness to loosen cytology material without substantial traumatization of tissue; and a detachable brush handle for the bristle shank. See Figures 1 and 9; Column 4, lines 19-35 and 50-60; and Column 5, lines 30-37.

Suci et al, however fail to disclose a dispensable, opaque marker carried by the cytology brush; a detent operably associated with the bristle shank for preventing inadvertent release of the detachable brush handle; the brush handle is slidably received within a housing and the detent is situated on the housing for operable engagement with the brush handle; and the housing is a tubular housing.

Art Unit: 3736

Vermeulen, as discussed above, disclose a wire-guided cytology brush and further disclose a dispensable, opaque marker carried by the cytology brush; a detent operably associated with the bristle shank for preventing inadvertent release of the detachable brush handle; the brush handle is slidably received within a housing and the detent is situated on the housing for operable engagement with the brush handle; and the housing is a tubular housing. See Figures 1 and 3.

Since both Suciu et al and Vermeulen disclose cytology brush systems, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the cytology brush system of Suciu et al to include the use of a detent and a biopsy marker, as per the teachings of Vermeulen, since it would provide a means of preventing the removal of the brush as well as marking the site from which the biopsy was taken.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art at the time the invention was made to mount the detent of Vermeulen in a hinged relationship with the housing since the Applicant has not disclosed that the hinged mounting of the detent provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Vermeulen's detent, and the Applicant's invention to perform equally well with either detent taught by Vermeulen or the claimed detent because both detents prevent the removal of the brush from the elongated housing.

Art Unit: 3736

5. Claims 10 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suci et al (4,227,537) and Vermeulen (5,201,323) as applied to claims 9 and 25 above, and further in view of Sirimanne et al (2002/0035324 A1).

Suci et al and Vermeulen, as discussed above, disclose cytology brush systems, but fail to disclose the marker is an outwardly biased coil; and the marker is a titanium coil. Sirimanne et al disclose a means for marking a biopsy site and further disclose the marker is an outwardly biased coil; and the marker is a titanium coil. See Paragraph 0060.

Since the combination of Suci et al and Vermeulen disclose the use of a detachable marker, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Suci et al and Vermeulen to include the use of a coil as a marker, as per the teachings of Sirimanne et al, since it is well known in the art to utilize markers of various shapes to mark biopsy sites.

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

Art Unit: 3736

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

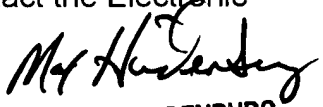
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Szmaj whose telephone number is (571) 272-4733. The examiner can normally be reached on Monday-Friday, with second Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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